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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,561	06/16/2006	David George Allen	PB60739	7890
20462	7590	10/30/2007		
SMITHKLINE BEECHAM CORPORATION CORPORATE INTELLECTUAL PROPERTY-US, UW2220 P. O. BOX 1539 KING OF PRUSSIA, PA 19406-0939			EXAMINER RAHMANI, NILOOFAR	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 10/30/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

US\_cipkop@gsk.com

<b>Office Action Summary</b>	Application No. 10/596,561	Applicant(s) ALLEN ET AL.	
	Examiner Niloofer Rahmani	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 73-136 is/are pending in the application.
- 4a) Of the above claim(s) 124-127 and 136 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73-123 and 128-135 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 73-136 are currently pending in the instant application. Claims 1-72 are cancelled.

There is no traversal on the paper dated on 09/04/2007. Therefore, it is considered as without traverse. Applicant's election of group I in the reply filed on 09/04/2007 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

Claims 73-123, 128-135(in part), wherein Ar being (x), A being C-R<sup>6A</sup>, B being C-R<sup>6B</sup>, D being C-R<sup>6D</sup>, E being C-R<sup>6E</sup>, F being C-R<sup>6F</sup> are examined. Claims 124-127, 136(full), and claims 73-123, 128-135(in part), remaining subject matter being drawn to the non-elected invention are withdrawn per 37 CFR 1.142(b).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Priority***

2. This application was filed on 06/16/2006, which is a 371 of PCT/EP04/14490, filed on 12/17/2004. Acknowledgement is made of Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d), by EUROPEAN PATENT OFFICE (EPO) PCT/EP03/14867, filed on 12/19/2003, and UNITED KINGDOM

0405899.6, filed on 03/16/2004, and UNITED KINGDOM 0405936.6, filed on 03/16/2004, and UNITED KINGDOM 0406754.2, filed on 03/25/2004.

**3. *Claim Rejections - Obvious Double Patenting***

Claims 73-123, 128-135 are provisionally rejected under the judicially created doctrine obviousness-type double patenting as being unpatentable over the claims 1-51 of the Allen et al., of the application # 10/527,866. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current invention embraces the invention claimed in the above patent.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Allen et al. claimed identical compounds in claims 1-51 as the instant claims 73-123, and 128-135.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the instant claims and the issued claims is the claims are not word for word identical but the scope of both sets of claims overlaps mostly significantly with each other.

*Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)*

The instant claims 73-123, and 128-135 are therefore fully embraced by the issue claims 1-51 of Allen et al.

This is provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been issued.

**The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the**

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“right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 168 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130 (b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**4. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 73-123, 128-135 are rejected under 35 U.S.C. 102(e) as being anticipated by Allen et al. Wo 2004/024728. Allen et al. disclosed the instant claimed compounds on pages 155-160, Example 21-63, page 160, Example 67-69, page 161, Example 74, page 163, Example 85, page 164, example 86-91, page 165, Example 91 and 95, page 166, example 96-98, pages 167-175, Example 100-109, page 177, Example 167-178, page 179, Example 187, page 180, Example 188, page 181, Example 191, page 182-184, Example 192-201, pages 189-190, Example 214-230, page 191, example 231-239, page 192, Example 240-249, pages 194-196, Example 259-275, pages 196-198, Example 276-287, page 198, example 188-189, pages 199-201, Example 291-309, page 210, Example 312, page 201, Example 314-318, page 206, example 350-351, page 207, Example 352-353, page 208, Example 356, page 209, Example 357, pages 210-213, example 360-413, page 214, example 420, page 215, Example 421, pages 215-217, example 423-458, page 217, Example 460-462, page 217, Example 464-482, pages 218-219, example 464-482, pages 219-220, example 484-489, pages 222-244, Example 492-688. Therefore, the instant claim is anticipated by Allen et al.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on 571-272-0867. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

10/19 /2007

NR



D. MARGARET SEAMAN

PRIMARY EXAMINER

GROUP 1625